

REMARKS

The Examiner has objected to the title of the invention as being not descriptive. The title of the invention has accordingly been amended to be clearly indicative of the invention to which the claims are directed.

Claims 1-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bell et al.* (U.S. 5,875,293) in view of *Schaefer* (U.S. 6,487,610). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP §2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

Independent claims 1, 10, 19 and 28 include:

"a computer system under test having a plurality of ports and including a processor and a memory and configured to boot using a system firmware, the system firmware including instructions for causing the computer system to detect a test apparatus coupled to transfer information to any port accessing the processor of the computer system."

The cited references do not teach or suggest a computer system under test having a plurality of ports and including a processor and a memory and configured to boot using a system firmware, the system firmware including instructions for causing the computer system to detect a test apparatus coupled to transfer information to any port accessing the processor of the computer system.

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because neither *Bell et al.* patent nor the *Schaefer* patent teaches or even suggests the desirability of the combination. Moreover, neither patent provides any incentive or motivation supporting the desirability of the combination.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re*

Geiger, the court stated in holding that the PTO “failed to establish a *prima facie* case of obviousness”:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the Applicant’s disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet* , 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had “reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious.” The court noted that to “prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness.” The court further noted that there were three possible sources for such motivation, namely “(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art.” Here, according to the court, the board had relied simply upon “the high level of skill in the art to provide the necessary motivation,” without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: “If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.”

Therefore, independent claims 1, 10, 19 and 28 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-30 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



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